

REMARKS/ARGUMENTS

The Restriction Requirement

The Examiner has requested restriction under 35 USC §121 to one of the following groups:

- I. Claims 1-7 drawn to a benzobisazole polymer, classified in Class 528, subclass 422
- II. Claim 8 drawn to a method for preparing 1,5-naphthalenedicarboxylic acid, classified in class 528, subclass 482

Applicants respectfully traverse the requirement for restriction on the grounds that Group I and Group II are not independent and distinct inventions under 35 USC §121. The Examiner makes the allegation that Group I belongs to subclass 422 and that Group II belongs to subclass 482. This does not meet the Examiner's burden of showing that they are distinct based on separate classification. First, subclasses are by definition related to each other – they both belong under a single class. The classification under separate subclasses is simply for cataloging purposes and is not sufficient justification to support a restriction requirement. Second, Group I and Group II each belong to both cited subclasses. Group I belongs to subclass 482 as well as to 422; likewise, Group II belongs to subclass 422 as well as to 482. Indeed, there are likely a number of other subclasses in which both Group I and Group II could be asserted to belong. The Examiner has not provided any evidence that each has attained recognition in the art as a separate subject for inventive effort or that a separate field of search is necessary or even appropriate.

The Examiner further states that “the process for using the product as claimed can be practiced with another materially different product such as each species of Claim 1”. However, as discussed in detail below, all of the claimed compounds of Claims 1-7 are so closely related that a search to determine the patentability of any of the claimed benzobisazole polymers “species” will necessarily include all of the other claimed

benzobisazole polymer "species". Since the species are related and a search of any one species will necessarily include a search of the other species, all claims should be examined in one application.

Accordingly, the Applicants respectfully request that that the restriction requirement be withdrawn and that the Groups I-II subject matter of Claims 1-8 be examined together.

Election of Group I

In the event that the Examiner makes this restriction requirement final, Applicants elect Group I -- Claims 1-7. This election is made without prejudice to Applicants' right to pursue the patenting of all presently non-elected claims in a divisional application.

Election of Group I Species

The Examiner goes on to state that in the case if Applicants elect Group I, then a further restriction is required. In particular, the Examiner states that the application contains claims directed to the following patentably distinct species of the claimed invention:

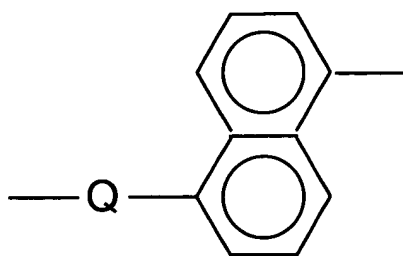
- (a) a species of claim 2
- (b) a species of claim 3
- (c) a species of claim 4
- (d) a species of claim 5
- (e) a species of claim 6, and
- (f) a species of claim 7.

Applicants respectfully traverse the requirement for election of a single species on the grounds that the Examiner has failed to make a prima facie case for election of a single species under the law. Although the Examiner alleges that the species are

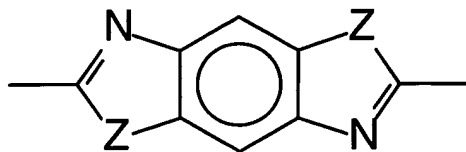
“patentably distinct”, he has provided no reasons to support his allegations. Importantly, the Examiner has failed to show, as required, why the allegedly “patentably distinct species” must be restricted on the basis of (a) separate classification; (b) separate status in the art; or (c) a different field of search. Indeed, the Examiner has not provided any evidence that each “patentably distinct species” has attained recognition in the art as a separate subject for inventive effort or that a separate field of search is necessary or even appropriate. Accordingly, the Examiner has failed to make a prima facie case for restriction.

Clearly, all of the claimed compounds of Claims 1-7 are so closely related that a search to determine the patentability of any of the claimed benzobisazole polymers “species” will necessarily include the other claimed benzobisazole polymer “species”. Since the species are related and a search of any one species will necessarily include a search of the other species, all claims should be examined in one application. Accordingly, the Applicants respectfully request that the election of species requirement be withdrawn, and the subject matter of Claims 1-7 be examined together.

In the event that the Examiner makes this election of species requirement final, Applicants elect a species of Claims 2. In particular the Applicant's elect the following species of Claim 2: A benzobisazole polymer having repeating units of the formula:



Wherein Q is



And Z is -O-.

Currently no claim reads on the elected species.

This election is made without prejudice to Applicants' right to pursue the patenting of all presently non-elected species in a divisional application.

The Applicants respectfully requests that the Examiner, in the event the Examiner does not reconsider and withdraw the restriction requirement, makes this restriction requirement final for purposes of 37 CFR §1.144.

Conclusions

In light of the foregoing remarks, it is submitted that an election of species requirement is not appropriate in the present application. Accordingly, the Examiner is respectfully requested to withdraw the election of species requirements.

Should the Examiner have any questions or wish to further discuss this matter, it is requested that the undersigned attorney be contacted at (937) 255-2838.

Respectfully submitted,

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